

Remarks

The instant Office Action dated December 12, 2007, notes the following rejections: claims 1, 4-16, 19, 22-27, and 29-31 stand rejected under 35 U.S.C. § 102(e) over Shiraishi (U.S. Patent No. 6,954,538); claims 2-3, 17 and 20-21 stand rejected under U.S.C. § 103(a) over Shiraishi and further in view of Deluca (U.S. Patent No. 6,434,239); and claim 18 stands rejected under U.S.C. § 103(a) over Shiraishi and Deluca and further in view of Spencer (U.S. Patent No. 7,224,808).

Applicant respectfully traverses the rejections presented in the instant Office Action because the cited portions of the Shiraishi reference are largely unrelated to the claimed invention. More specifically, the claimed invention is directed to aspects involving including an identification signal in an audio signal that is being outputted by a source (*e.g.*, music from a speaker that is being listened to by a user). The identification signal is received by a remote control and the remote control identifies the source of the audio signal from the identification signal thereby enabling the user to control the source using the remote control (*e.g.*, adjust the volume). In contrast, the cited portions of the Shiraishi reference teach a dedicated setup mode in which receiver 100 outputs a series of predetermined test tone signals from each of the speakers. *See, e.g.*, Figure 1 and Col. 6:27-54. In Shiraishi's setup mode an audio signal is not being listened to by a user and Shiraishi's remote control apparatus 300 does not enable the user to control the test tone signals. Shiraishi's receiver 100 controls each of the speakers, in a specified sequence at predetermined timing intervals, to output a noise pulse that has a certain frequency and a certain sound pressure level. Shiraishi's test tone signals are received by remote control apparatus 300, which analyzes the received test signals and then provides configuration information to receiver 100 based upon the results of the analysis. Thus, the cited portions of the Shiraishi reference do not teach including an identification signal in an audio signal as in the claimed invention. The cited portions of Shiraishi also do not teach enabling the user to adjust the test tone signals based upon an identification signal received by a remote control. The following discussion particularly addresses the impropriety of the Office Action's rejections with reference to specific claims.

Applicant respectfully submits that the § 102(e) rejection of claims 1, 4-16, 19, 22-27, and 29-31 cannot stand because the cited portions of the Shiraishi reference do not

correspond to the claimed invention which includes, for example, aspects directed to combining an identification signal that identifies the acoustic source with the input audio signal to produce the output audio signal. In contrast to the claimed invention, the cited portions of Shiraishi teach a dedicated setup mode in which receiver 100 outputs a series of predetermined test tone signals from each of the speakers. *See, e.g.*, Figure 1 and Col. 6:27-54. These test tone signals are received by remote control apparatus 300, which analyzes the received test tone signals, determines speaker configuration information and provides this configuration information to receiver 100. Thus, the cited portions of Shiraishi do not teach combining an identification signal with an input audio signal to produce an output audio signal; instead Shiraishi's receiver 100 generates a series of predetermined test tone signals that are outputted from each of the speakers. Accordingly, Applicant requests that the § 102(e) rejection of claims 1, 4-16, 19, 22-27, and 29-31 be withdrawn.

Applicant respectfully traverses the § 103(a) rejections of claims 2-3, 17-18 and 20-21 because the Office Action fails to provide adequate detail regarding the proposed combination of the Shiraishi and Deluca references to enable Applicant to determine the propriety of such a combination. In order to comply with 35 U.S.C. § 132, sufficient detail must be provided by the Examiner regarding the alleged correspondence between the claimed invention and the cited reference to enable Applicant to adequately respond to the rejections. *See, also*, 37 CFR 1.104 ("The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.") and M.P.E.P. § 706.02(j), ("It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.")

In this instance, the Office Action simply discusses the largely unrelated teachings of the Shiraishi and Deluca references without providing any information regarding how these teachings are to be combined. As discussed above, the cited portions of Shiraishi are directed to a dedicated setup mode involving a receiver 100 and a remote control apparatus 300 in which receiver 100 outputs a series of predetermined test tone signals from each of the speakers. *See, e.g.*, Figure 2 and Col. 6:27-54. In contrast, the cited portions of Deluca are directed to outputting an acoustic signal 90, having a modulated ultrasonic carrier signal, from a device 10 in order to cancel out sound from an audio source 20. *See, e.g.*, Figure 1

and Col. 2:24-43. Applicant notes that the cited portions of Deluca do not teach an inaudible identification signal or an ultrasonic identification signal and the cited portions of Deluca also do not each modulating an audio signal with an identification signal. In contrast, the cited portions of Deluca teach modulating the ultrasonic carrier signal with a sound canceling signal. Thus, Applicant submits that it is unclear how the Office Action is proposing to combine these references based on their teachings because the cited teaching appear to be unrelated (*e.g.*, the cited portions of Shiraishi do not mention canceling sound from any audio source).

In the event that the Office Action is proposing to somehow modify Shiraishi's test tone signals with the teachings of Deluca, Applicant submits that such a modification would render Shiraishi unsatisfactory for its intended purpose. According to M.P.E.P. § 2143.01(V), if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *See, also In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As discussed above, Shiraishi's setup mode requires that receiver 100 control each of the speakers, in a specified sequence at predetermined timing intervals, to output a noise pulse that has a certain frequency and a certain sound pressure level. *See, e.g.*, Col. 6:37-41. Applicant submits that modifying the specific test tone signals required by the Shiraishi reference (*e.g.*, to have a modulated ultrasonic carrier signal as taught by Deluca) would render Shiraishi unsatisfactory for its intended purpose of configuring receiver 100. *See, e.g.*, Figure 1 and Col. 6:27-54.

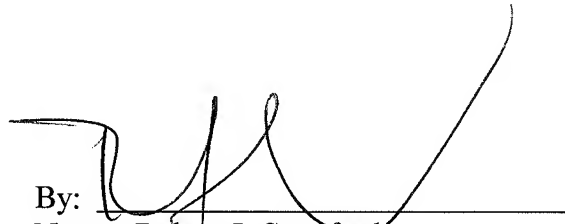
In view of the above, the Office Action fails to provide adequate detail regarding the proposed combination of the Shiraishi and Deluca references to enable Applicant to determine the propriety of such a combination. Accordingly, the § 103(a) rejections of claims 2-3, 17-18 and 20-21 are improper and Applicant requests that they be withdrawn. Should any rejection based upon the Shiraishi and Deluca references be maintained, Applicant respectfully requests clarification regarding how the Office Action is proposing to combine these references. Applicant appreciates the effort put forth in the Office Action to explain the rationale behind the claim interpretations and the rejections; however, as discussed above, the Office Action has not provided adequate detail regarding the proposed combination of the Shiraishi and Deluca references. In an effort to facilitate prosecution,

Applicant has attempted to ascertain the combination believed to be relied upon by the Office Action. Should any of Applicant's efforts not coincide with an undisclosed rationale behind the Office Action's argument, Applicant respectfully requests clarification and an opportunity to respond. *See, e.g.,* M.P.E.P. § 706.07 stating that "(b)efore final rejection is in order a clear issue should be developed between the examiner and applicant . . . The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal."

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

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